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Clyde L. Smith  
Reg. No. 46,292

In re application of: SMITH, Clyde

Serial No.: 10/721,041

Examiner: FLORES-SANCHEZ, Omar

Filed: November 24, 2003

Group Art Unit: 3724

For: METHOD AND  
APPARATUS  
FOR SCRIBING TILE

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APPEAL BRIEF

Appellant hereby Appeals the rejections set forth in Office Action of November 17, 2006.

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TRANSMITTAL LETTER  
(General – Patent Pending)

Docket No.

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In Re Application Of:  
SMITH, Clyde

Serial No.  
10/721,041

Filing Date  
November 24, 2003

Examiner  
FLORES-SANCHEZ, Omar

Group Art Unit  
3724

Title:

METHOD AND APPARATUS FOR SCRIBING TILE

TO THE COMMISSIONER OF PATENTS AND TRADEMARKS

Transmitted herewith is:  
An Appeal Brief under 37 CFR §41.37

in the above identified application.

- No additional fee is required.
- A check in the amount of \$250 for the filing of an Appeal Brief is attached.
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Dated: August 20, 2007

Clyde L. Smith, Reg. 46,292

314-602-6338

I certify that the document and fee is being deposited on August 20, 2007 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner of Patents and Trademarks, P.O. Box 1450, Alexandria, VA 22313-1450.

Clyde L. Smith  
Typed or Printed Name of Person Mailing Correspondence

**(i) Real Party In Interest**

I, Clyde Lewell Smith, am the real party in interest, being the sole owner of all rights to the present application and the invention disclosed therein.

**(ii) Related Appeals And Interferences**

I am unaware of any other related prior or pending appeals, interferences or judicial proceedings which may be related to, directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

**(iii) Status Of The Claims**

Claims 1-15, and 35-39 are pending in the present application. Claims 16-34 have been canceled. Claims 1-6, 10, 11, 14, 15, and 35-39 stand finally rejected under 35 USC § 102(b) as being anticipated by U.S. Pat. No. 5,701,680 invented by Garcia et al (hereinafter Garcia). Claims 7-9, 12, and 13 stand finally rejected under 35 USC §103(a) as being obvious over Garcia in view of U.S. Pat. No. 5,012,586 invented by Ashworth (hereinafter Ashworth). Appellant appeals the rejections of claims 1-15, and 35-39.

**(iv) Status Of Amendments**

No amendments have been filed subsequent to final rejection.

**(v) Summary Of The Claimed Subject Matter**

The claims contain no means-plus-function nor do they contain any step-plus-function limitation.

**(1) Independent Claim 1**

Claim 1 is directed to an apparatus for scribing tile. The apparatus comprises a

scribe member, a tile engagement member, an extension member, and a locking member. Page 3 of the specification, lines 16-18. The scribe member 102 is a portion of the apparatus along which a person can scribe tile (i.e., mark a cutting path on a piece of tile). Figures 25 and 26; page 26 of the specification, lines 19-22; and page 28 of the specification, line 21, to page 29, line 2. The tile engagement member 106 is a portion of the apparatus that engages against edges existing laid tile and against edges of the tile to be scribed to provide a reference to accurately position the scribe member on the tile to be scribed. Figures 25 and 26; page 27 of the specification, lines 6-9 and 14-18; and page 28 of the specification, lines 10-20. The extension member 104 connects the scribe member 102 to the tile engagement member 106 and is movably connected to the tile engagement member. Figures 25 and 26; page 3 of the specification, lines 18-21. The locking member 108 is movable between a locking position and an unlocking position and prevents movement of the tile engagement member 106 relative to the extension member 104 when the locking member is in the locking position, while it allows movement of the tile engagement member relative to the extension member when the locking member is in the unlocking position. Figures 23-26; page 3 of the specification, line 21, to page 4, line 3. The key limitation that distinguish the invention of claim 1 over the prior art is that the locking member 108 is biased from the unlocking position toward the locking position. Page 4 of the specification, lines 3-4. This is what allows the apparatus to be both versatile and yet usable via only two hands. Page 1, line 22, to page 2, line 14.

(2) Independent Claim 35

Claim 35 is directed to an apparatus for scribing tile. The apparatus comprises a scribe member, a tile engagement member, and an extension member. Page 3 of the specification, lines 16-18. The scribe member 102 is a portion of the apparatus along which a person can scribe tile (i.e., mark a cutting path on a piece of tile). Figures 25

and 26; page 26 of the specification, lines 19-22; and page 28 of the specification, line 21, to page 29, line 2. The tile engagement member 106 is a portion of the apparatus that engages against edges existing laid tile and against edges of the tile to be scribed to provide a reference to accurately position the scribe member on the tile to be scribed. Figures 25 and 26; page 27 of the specification, lines 6-9 and 14-18; and page 28 of the specification, lines 10-20. The extension member 104 connects the scribe member 102 to the tile engagement member 106 and is movably connected to the tile engagement member. Figures 25 and 26; page 3 of the specification, lines 18-21. The extension member 104 connects the scribe member 102 to the tile engagement member 106 and has a locked configuration with the tile engagement member that prevents relative movement between the extension member and the tile engagement member. Figures 23-26; page 3 of the specification, line 21, to page 4, line 3. The tile engagement member also has an unlocked configuration with the tile engagement member that allows said movement between the extension member and the tile engagement member. Figures 23-26; page 3 of the specification, line 21, to page 4, line 3. The key limitation that distinguish the invention of claim 35 over the prior art is that the apparatus is configured and adapted such that an external force acting on the apparatus is required to prevent the extension member and the tile engagement member from being in their locked configuration. Page 22 of the specification, lines 5-12. This is what allows the apparatus to be both versatile and yet usable via only two hands. Page 1, line 22, to page 2, line 14.

(vi) Grounds Of Rejection To Be Reviewed On Appeal

Appellant requests the Board to reconsider and withdraw the rejection of claims 1-6, 10, 11, 14, 15, and 35-39 under 35 USC § 102(b) as being anticipated by U.S. Pat. No. 5,701,680 invented by Garcia et al (hereinafter Garcia).

Appellant requests the Board to reconsider and withdraw the rejection of claims 7-9, 12, and 13 under 35 USC §103(a) as being obvious over Garcia in view of U.S. Pat. No. 5,012,586 invented by Ashworth (hereinafter Ashworth).

(vii) Argument

1. The Rejection Of Claims 1-6, 10, 11, 14, 15, And 35-39 Under 35 USC § 102(b) As Being Anticipated By U.S. Pat. No. 5,701,680 (Garcia)

(a) **arguments applicable to claims 1-6, 10, 11, 14, and 15 as a group**

Claim 1 requires, among other things, the locking member, which selectively prevents or allows movement of the tile engagement member relative to the extension member, to be “biased from the unlocking position toward the locking position.” Garcia comprises a locking member, which selectively prevents or allows movement of the tile engagement member relative to the extension member, but which is not “biased from the unlocking position toward the locking position.” The locking member of Garcia, which selectively prevents or allows movement of the tile engagement member (“cup block 136”) relative to the extension member (“cup slide 122”), is a “threaded fitting 138” that must be manually spun to lock or unlock the tile engagement member 135 relative to the extension member 122. Garcia, column 3, lines 63-67. As the Examiner acknowledges in Final Office Action, the locking nut 138 is biased toward its locking position only by “[t]he user’s hand, which is an external force.” Office Action November 17, 2006, numbered paragraph 5. Appellant submits that a user’s hand can not constitute part of Garcia’s apparatus for scribing tile for purposes of an anticipation rejection under 35 USC §102. Thus, the apparatus of Garcia does not comprise a locking member that is biased from its unlocking position toward its locking position, as is required by claim 1. For these reasons the rejection of claim 1 is improper and should be withdrawn. Likewise, it follows that, because claims 2-6, 10, 11, 14, and 15 are dependent upon

claim 1, for these same reasons the rejection of claims 2-6, 10, 11, 14, and 15 is improper and should be withdrawn.

The rejection under 102(b) is apparently predicated on the Examiner's failure to give the limitation "the locking member being biased from the unlocking position toward the locking position" any weight. The Examiner mistakenly construes this limitation to be merely an intended use limitation. Office Action November 17, 2006, numbered paragraph 5. Appellant submits that claim 1 does not recite any particular use of the claimed apparatus. In contrast, claim 1 does require the locking member of an apparatus to be "biased from the unlocking position toward the locking position." The Federal Circuit has defined the term "biased" as a structural limitation. (See, *L & W Inc. v. Shertech Inc.*, 81 USPQ2d 1198, 1204 (Fed. Cir. 2006)(the court holding that the claim limitation "biased toward the adjacent sheets" did not require particular steps, but did require sheets to be biased toward other adjacent sheets). It is therefore improper for the Examiner to ignore this limitation as being merely an intended use.

The Examiner also states that the claims "don't disclose any structure or anything that biases the locking member from the unlocking position toward the locking position." Office Action November 17, 2006, numbered paragraph 5. This statement is irrelevant to a proper rejection of the claims under 35 USC §102, which requires a single prior art reference to disclose each and every claimed limitation. 35 USC §102 does not require a claim to disclose each and every limitation of the preferred embodiment.

#### **(b) arguments applicable to claims 35-39 as a group**

Claim 35 requires, among other things, the apparatus to be "configured and adapted such that an external force acting on the apparatus is required to prevent the extension member and the tile engagement member from being in their locked configuration." The rejection of claim 35 fails to address this limitation and therefore fails to constitute even a *prima facie* anticipation rejection. Moreover, as discussed above,

the Examiner acknowledges that the locking nut 138 of Garcia is biased toward its locking position only by “[t]he user’s hand, which is an external force.” Office Action November 17, 2006, numbered paragraph 5. Thus absent an external force, the locking member of Garcia will remain in its unlooked position absent an external force and therefore the apparatus of Garcia is not “configured and adapted such that an external force acting on the apparatus is required to prevent the extension member and the tile engagement member from being in their locked configuration,” as is required by claim 35. For these reasons the rejection of claim 35 is improper and should be withdrawn. Likewise, it follows that, because claims 36-39 are dependent upon claim 35, for these same reasons the rejection of claims 36-39 is improper and should be withdrawn.

**(c) arguments applicable to claims 2-6, 36, and 37 as a group**

Claim 2 and 36 each require the extension member of the claimed apparatus to be both pivotally and slideably movable relative to the tile engagement member. The tile engagement member of Garcia (“cup block 126”) is groove to “closely receive” the extension member (“cup slide 122”). Garcia, col. 4, lines 1-4. This keeps the extension member at a perfect ninety degrees relative to the extension member. Id. at col. 3, lines 26-29. As such, the tile engagement member of Garcia is slideably, but not pivotally moveable relative to the tile engagement member. Thus, Garcia fails to disclose any apparatus that has a tile engagement member that is both pivotally and slideably movable relative to the tile engagement member, as is required by each of claims 2 and 36. For these reasons the rejection of claims 35 and 2 is improper and should be withdrawn. Likewise, it follows that, because claims 3-6 and 37 are dependent upon claims 2 and 36, respectively, for these same reasons the rejection of claims 3-6 and 37 is improper and should be withdrawn.

2. The Rejection Of Claims 7-9, 12, and 13 Under 35 USC § 103(a) As Being Obvious over Garcia in view of U.S. Pat. No. 5,012,586 (Ashworth)

**(a) arguments applicable to claims 7-9, 12, and 13 as a group**

As discussed above in Section (vii)1.(a), Garcia fails to disclose an apparatus that comprises a locking member that is biased from its unlocking position toward its locking position, as is required by claim 1. Ashworth also fails to disclose such a locking member.

The first embodiment of the drafting apparatus described in Ashworth comprises two locking means. One of the locking means comprises an annular locking ring 110 that pivots about two annular clutch segments 42. Ashworth, Figure 4. The locking ring 110 can be manually pivoted relative to the clutch segments 42 in a manner to selectively lock and unlock separate parts of the drafting apparatus relative to each other. After the locking ring of Ashworth has been moved to its locking position, the locking ring will remain in the locking position when the drafting apparatus is released and until an external force is applied to pivot the locking ring to the unlocking position. Ashworth, col. 6, lines 46-63. Similarly, after the locking ring of Ashworth has been moved to its unlocking position the locking ring will remain in the unlocking position when the drafting apparatus is released and until an external force is applied to pivot the locking ring to the locking position. Id. Nonetheless, nothing in Ashworth suggests that the locking member is or should be biased from the unlocking position to the locking position. The other locking mechanism of Ashworth comprises a spring biased "grippable portion" 102. Ashworth, Figure 3. However, as disclosed in Ashworth, the grippable portion is biased from a locking position to an unlocking position when the drafting apparatus is released. Ashworth, col. 6, lines 5-17.

In view of the foregoing, even in combination, Garcia and Ashworth fail to render obvious an apparatus for scribing tile that comprises a locking member that is biased from the unlocking position toward the locking position as required by claim 1. As such, it follows that claims 7-9, 12, and 13, which are each dependent upon claim 1, are not

rendered obvious by the combination of Garcia and Ashworth.

**(b) arguments applicable to claims 7-9 as a group**

Claims 7-9 are each dependent upon claim 2. As discussed above in Section (vii)1.(c), claim 2 requires the extension member of the claimed apparatus to be both pivotally and slideably movable relative to the tile engagement member. For the reasons discussed in Section (vii)1.(c), Garcia fails to disclose this limitation. Additionally, Ashworth fails to disclose any extension member that is both pivotally and slideably movable relative to tile engagement member. Thus, even in combination, Garcia and Ashworth can not a do not render obvious claim 2. As such, it follows that claims 7-9, being dependent upon claim 2, are also not obvious in view Garcia and Ashworth.

**(c) arguments applicable to claim 7**

Claim 7 requires, among other things, an actuation portion that is movable toward the pivot axis in a manner to move the locking member from the locking position to the unlocking position and that is movable away from the pivot axis in a manner to move the locking member from the unlocking position to the locking position. Even in combination, Ashworth and Garcia fail to disclose such a limitation. As such, claim 7 is not obvious in view of Garcia and Ashworth.

**(d) arguments applicable to claim 13**

Claim 13 requires, among other things, first and second actuation portions that are movable toward each other in a manner to move the locking member from the locking position to the unlocking position and that are movable away from each other in a manner to move the locking member from the unlocking position to the locking position. Even in combination, Ashworth and Garcia fail to disclose such a limitation. As such, claim 13 is not obvious in view of Garcia and Ashworth.

(viii) Claims Appendix

1. (original)

An apparatus for scribing tile comprising:

- a scribe member;
- a tile engagement member;
- an extension member, the extension member connecting the scribe member to the tile engagement member, the extension member being movably connected to the tile engagement member; and
- a locking member, the locking member being movable between a locking position and an unlocking position, the locking member preventing movement of the tile engagement member relative to the extension member when the locking member is in the locking position and allowing movement of the tile engagement member relative to the extension member when the locking member is in the unlocking position, the locking member being biased from the unlocking position toward the locking position.

2. (original)

An apparatus in accordance with claim 1 wherein the extension member is both pivotally and slideably movable relative to the tile engagement member when the locking member is in the unlocking position.

3. (original)

An apparatus in accordance with claim 2 wherein the scribe member is pivotally connected to the extension member.

4. (original)

An apparatus in accordance with claim 3 wherein the scribe member is pivotally connected to the extension member by a friction connection in a manner such that there is a frictional force that prevents pivotal movement of the scribe member relative to the extension member unless at least a threshold moment between the scribe member and the extension member is applied.

5. (original)

An apparatus in accordance with claim 2 wherein the locking member comprises a cam surface and wherein the tile engagement member comprises a cam surface, the cam surface of the locking member engaging the cam surface of the tile engagement member when the locking member is in the locking position in a manner such that the extension member is in clamped engagement with the tile engagement member.

6. (original)

An apparatus in accordance with claim 2 wherein the locking member is pivotally movable with the extension member relative to the tile engagement member.

7. (original)

An apparatus in accordance with claim 2 wherein the extension member is pivotally movable relative to the tile engagement member about a pivot axis and wherein the locking member comprises an actuation portion, the actuation portion being movable toward the pivot axis in a manner to move the locking member from the locking position to the unlocking position and being movable away from the pivot axis in a manner to move the locking member from the unlocking position to the locking position.

8. (original)

An apparatus in accordance with claim 2 wherein the apparatus further comprises a resilient portion that allows the locking member to resiliently deflect between the locking position and the unlocking position.

9. (original)

An apparatus in accordance with claim 8 wherein the locking member is biased from the unlocking position toward the locking position via the resilient portion.

10. (original)

An apparatus in accordance with claim 1 wherein the scribe member is pivotally connected to the extension member.

11. (original)

An apparatus in accordance with claim 10 wherein the scribe member is pivotally connected to the extension member by a friction connection in a manner such that there is a frictional force that prevents pivotal movement of the scribe member relative to the extension member unless at least a threshold moment between the scribe member and the extension member is applied.

12. (original)

An apparatus in accordance with claim 1 wherein the apparatus further comprises a resilient portion that allows the locking member to resiliently deflect between the locking position and the unlocking position, the locking member being biased from the unlocking position toward the locking position via the resilient portion.

13. (original)

An apparatus in accordance with claim 1 wherein the apparatus further comprises first and second actuation portions, the first and second actuation portions each being movable relative to the tile engagement member, the first and second actuation portions also being movable toward each other in a manner to move the locking member from the locking position to the unlocking position and being movable away from each other in a manner to move the locking member from the unlocking position to the locking position.

14. (original)

An apparatus in accordance with claim 1 wherein the locking member comprises a cam surface and wherein the tile engagement member comprises a cam surface, the cam surface of the locking member engaging the cam surface of the tile engagement member when the locking member is in the locking position in a manner such that the extension member is in clamped engagement with the tile engagement member.

15. (original)

An apparatus in accordance with claim 1 wherein the scribe member consists of a single monolithic member having a straight scribe edge.

16-34. (cancelled)

35. (previously presented)

An apparatus for scribing tile comprising:  
a scribe member;  
a tile engagement member;

an extension member, the extension member connecting the scribe member to the tile engagement member, the extension member having a locked configuration with the tile engagement member that prevents relative movement between the extension member and the tile engagement member and an unlocked configuration with the tile engagement member that allows said movement between the extension member and the tile engagement member, the apparatus being configured and adapted such that an external force acting on the apparatus is required to prevent the extension member and the tile engagement member from being in their locked configuration.

36. (previously presented)

An apparatus in accordance with claim 35 wherein the extension member is both pivotally and slideably movable relative to the tile engagement member when the extension member and the tile engagement member are in their unlocked configuration.

37. (previously presented)

An apparatus in accordance with claim 36 wherein the scribe member is pivotally connected to the extension member.

38. (previously presented)

An apparatus in accordance with claim 35 wherein the scribe member is pivotally connected to the extension member.

39. (previously presented)

An apparatus in accordance with claim 35 wherein the scribe member consists of a single monolithic member having a straight scribe edge.

(ix) Evidence Appendix

None

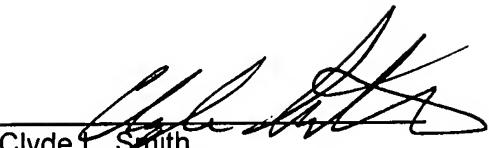
(x) Related Proceeding Appendix

None

Non oral hearing is requested.

Respectfully submitted,

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